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BRIEF FOR APPELLANT

Sir:

This is a Brief on appellant's Appeal from the Examiner's Final Rejection concerning the above-identified application.

The Commissioner is hereby authorized to charge any additional fees, which may be required to our deposit account No. 12-1155, including all required fees under: 37 C.F.R. §1.16; 37 C.F.R. §1.17; 37 C.F.R. §1.18.; 37 C.F.R. §1.136.

BRIEF FOR APPELLANT

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I. REAL PARTY IN INTEREST

Unilever Home & Personal Care USA, Division of Conopco, Inc. is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are no other prior or pending appeals or interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

III. STATUS OF CLAIMS

Claims 1, 3 and 6 are on Appeal. Claims 2 and 4-5 were canceled. Claims 1 and 3 were amended during prosecution.

IV. STATUS OF AMENDMENTS

Claims 1 and 3 were amended subsequent to the Final Office Action. These amendments were entered by the Examiner for purposes of Appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 relates to a cosmetic composition comprising a salt of malonic acid present as a half and a fully neutralized acid in a molar ratio ranging from about 1000:1 to about 1:1000, the salt having a cationic counter ion to malonate which is a cation of

an amine selected from the group consisting of ammonia, dimethylethanolamine, tris(hydroxymethyl)amino methane and combinations thereof; an organic sunscreen agent having a chromophoric group active within the ultraviolet radiation range of 280 to 400 nm; and a cosmetically acceptable carrier. See the specification at page 2, paragraph [0004]; page 2, paragraph [0006]; and page 4, paragraph [00010].

Dependent claim 3 focuses the molar ratio to a range from about 2:1 to about 1:200. See the specification at page 4, paragraph [00010].

Dependent claim 6 identifies the sunscreen agent as 4,4'-t-butyl-methoxydibenzoylmethane. See the specification at page 7, paragraph [00015].

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Are claims 1 and 3 unpatentable under 35 U.S.C. § 103(a) over Jokura et al. (U.S. Patent 5,641,495)?

Is claim 6 obvious under 35 U.S.C. § 103(a) over Jokura et al. (U.S. Patent 5,641,495) in view of Takada (JP 61/215318)?

Is claim 6 obvious under 35 U.S.C. § 103(a) over Jokura et al. (U.S. Patent 5,641,495) in view of Takada (JP 61/215318)?

VII. APPELLANT'S ARGUMENTS

Are claims 1 and 3 unpatentable under 35 U.S.C. § 103(a) over Jokura et al. (U.S. Patent 5,641,495)?

Appellant sought to solve the problem of discoloration in cosmetic compositions containing sunscreen agents. These agents are not always sufficiently stable in storage. Breakdown will degrade the UV protectant properties of the sunscreen agents. Appellant has solved this problem through use of malonate salts.

By contrast, Jokura et al. is focused upon achieving moisturization. There is no suggestion that the dicarboxylic acids implicated in achieving this moisturization would have any effectiveness at stabilizing sunscreen agents. Faced with a totally different problem, the skilled chemist would not have selected dicarboxylic acids, and most especially not malonic acid salts as stabilization actives.

In the Office Action of March 8, 2006, the Examiner has identified Example 3 as highly pertinent. Example 3 is titled "Sunscreen Milky Lotion With Moisturizing Effect". The formula under this Example includes 4-tert-butyl-4-methoxybenzoylmethane (sunscreen) and among other ingredients fumaric acid and sodium fumarate. The Examiner opines that one would be motivated to utilize malonic acid salts in place of the exemplified sodium fumarate (fumaric acid salt). From this it is concluded that selection of malonate salt is considered *prima facie* obvious.

Appellant respectfully differs from this opinion. The skilled chemist faced with the problem of stabilizing a sunscreen agent learns nothing from Example 3. Jokura et al. presents the dicarboxylic acids as moisturizing agents. Example 3 includes in its title

"Moisturizing Effect". There simply is no teaching, motivation or suggestion that sunscreen agents can be stabilized by dicarboxylic acids, much less malonic acid salts.

Indeed, not all dicarboxylic acids or their salts are effective at stabilization. Appellant claims the malonates as solving the stability problem. The broad category of "dicarboxylic acids" or their salts are neither presently claimed nor expected to have stabilization properties.

Claim 1 further specifies that the salt of malonic acid is present as the half neutralized and fully neutralized acid in a molar ratio ranging from about 1000:1 to about 1:1000. In other words, the malonate is present as a mono- and di- amine salt mixture.

Jokura et al. discloses the unneutralized acid (component B) and the partially neutralized acid (component C). The free acid can only co-exist with a partially neutralized salt because of pKa considerations. There is thus no disclosure of a fully neutralized malonic acid (i.e. formula II).

The Examiner has highlighted the reference as teaching a molar ratio of dicarboxylic acid to dicarboxylic acid salt as being from 1:9 to 9:1. Attention was drawn to column 3, lines 35-60. This ratio is different from that presently claimed. Jokura et al. has a ratio of free acid to neutralized acid. By contrast, appellant claims a ratio of mono to di-neutralized (i.e. half to fully neutralized) malonic acid. The ratio does not involve free acid.

The Examiner has argued that "the dicarboxylic acid salts and the composition of Jokura et al. must comprise a mixture of both fully neutralized and half neutralized acid, as the addition of alkali to the acid will result in a composition having some content of

both the fully and partially neutralized acid". See page 5, last paragraph, of the September 9, 2005 Office Action.

Addition of alkali to the free malonic acid would achieve mixtures of free and mono-salts. There would be no di-salt (fully neutralized) malonate present in a system that also included totally non-neutralized ("free") malonic acid. All three species, i.e. free, mono-salt (half neutralized) and di-salt (fully neutralized), could not coexist together. Yet the reference requires the presence of free acid, component B. Since the free acid must be present, the fully neutralized salt of that free acid could not coexist therewith. The pKa of malonic acid would not permit the presence of all three species. Thus, there is a fundamental inconsistency in Jokura et al. If the skilled chemist accepts the necessity for a free acid, then the di-salt of malonic could not be present. Jokura et al. lacks the claimed di-salt.

Another argument presented by the Examiner was that the reference teaches regulating the pH value between 3 and 10. From this it was reasoned that one would have been motivated to manipulate the ratio of the salt to acid since partial or full neutralization of the acid by the salt adjusts the pH of the composition. For instance, Jokura was said to teaching the importance of avoiding skin irritation due to the acid; thus the pH must be above 3 and below 10.

Appellant believes the Examiner's view is misguided. The problem with the pH argument is that Jokura et al. require the presence of free dicarboxylic acid. There clearly is a tension between the Jokura et al. requirement of a substantial free acid presence and the recitation of the pH rainbow. Those skilled in the art reading the reference would focus upon the requirement of a free dicarboxylic acid. The latter is mentioned in the Abstract and the independent claim 1. The pH range occurs in neither

the abstract nor the main independent claim. As explained *vide supra*, any neutralization which attempts to maintain free acid will not achieve the presence of a di-neutralized salt form. Only the free acid and the mono-salt can be there present in equilibrium. The skilled chemist being taught by the reference to maintain free dicarboxylic acid will only neutralize sufficient to maintain that acid and thereby not achieve the di-salt.

In summary, the reference provides no motivation leading a skilled chemist to resolve the problem of discoloration caused by sunscreen agents in cosmetic compositions. Jokura et al. is all about moisturization. The dicarboxylic acids mentioned therein at best can be said to operate as moisturizers; no other function is indicated. Secondly, Jokura et al. fails to disclose the amine malonate salt as being a mixture of di- and mono- salts. Appellant has outlined that any motivation in adjusting pH would be circumscribed by insuring the presence of substantial amounts of free acid. There could be no combination of mono- and di- salt unless all of the free acid were neutralized. The skilled chemist would be careful with the pH factor. Finally, the Examiner has extrapolated motivation to use a mixed di- and mono- amine type malonate from a reference which does not specifically mention this combination of salt, much less provide any specific example. Based on these considerations, the reference does not present a *prima facie* case of obviousness.

Is claim 6 obvious under 35 U.S.C. § 103(a) over Jokura et al. (U.S. Patent 5,641,495) in view of Takada (JP 61/215318)?

Jokura et al. formulate ingredients to achieve moisturization. Dicarboxylic acids to the extent that any function is disclosed, could only be described as performing a moisturization function. The reference is not concerned with solving discoloration arising

from sunscreens. This reference also fails to disclose amine salts of malonic acid which are combinations of di- and mono- salts.

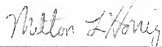
Takada does face a similar problem to that of appellant. Discoloration of the sunscreen composition is prevented through use of organic acids and/or their salts. These organic acids/salts can be monocarboxylic or dicarboxylic. Reported examples of the former include lactic acid, butyric acid, formic acid, acetic acid and propionic acid. The latter are exemplified by citric acid, tartaric acid, oxalic acid and malonic acid. Indeed, there is only a single mention of "malonic acid". See the translation at page 2, line 28.

Unlike the present claims, Takada does not disclose amine cationic counterions of malonic acid. No malonate salt whatsoever is described. To the extent that Jokura et al. references amine counterions, there would be no motivation to utilize these in Takada. The Jokura et al. document shows nothing special whatsoever about amine cationic counterions. The Examples all use sodium or potassium salts (and also the free acid). Yet even if the skilled chemist were to consider the amine cationic counter ions, Jokura et al. at best would suggest moisturization properties rather than color stabilization effectiveness. These two references do not complement each other.

A combination of Jokura et al. in view of Takada would not render the instant invention obvious. Both of these references fail to disclose or suggest mixtures of mono- and di- amine salts of malonic acid. For this reason, the combination does not render the claims *prima facie* obvious.

In view of the foregoing remarks, appellant requests the Board of Appeals and Interferences to reverse the Examiner's rejection of the claims.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Milton L. Honig".

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201-894-2403

VIII. CLAIMS APPENDIX

Claim 1. A cosmetic composition comprising:

- (i) from about 0.0001 to about 30% by weight of a salt of malonic acid present as a half neutralized and a fully neutralized acid in a molar ratio ranging from about 1000:1 to about 1:1000, the salt having a cationic counter ion to malonate which is a cation of an amine selected from the group consisting of ammonia, dimethylethanolamine, tris(hydroxymethyl)amino methane and combinations thereof;
- (ii) from about 0.05 to about 40% by weight of an organic sunscreen agent having a chromophoric group active within the ultraviolet radiation range of 280 to 400 nm; and
- (iii) from about 1 to about 99.9% by weight of a cosmetically acceptable carrier.

Claim 3. The composition according to claim 1 wherein the molar ratio is about 2:1 to about 1:200.

Claim 6. The composition according to claim 1 wherein the sunscreen agent is 4,4'-t-butyl-methoxydibenzoylmethane.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.